



#14/Reply Brief
J. Ellis
2-2-04
Docket No.: M3653.0001/P001-B
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sandra K. Richardson et al.

Application No.: 09/536,383

Confirmation No.: 5614

Filed: March 28, 2000

Art Unit: 3625

For: METHOD AND APPARATUS FOR
PLANNING AND MONITORING
MULTIPLE TASKS AND EMPLOYEE
WORK PERFORMANCE BASED ON USER
DEFINED CRITERIA AND PREDICTIVE
ABILITY

Examiner: F. Thompson

RECEIVED
JAN 29 2004
GROUP 3600

APPELLANT'S REPLY BRIEF

Attention: Board of Patent Appeals and Interferences

Commissioner for Patents

Washington, DC 20231

Dear Sir:

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. 1.103 and in response to the
Examiner's Answer dated November 25, 2003, Appellants hereby submit in triplicate
this Reply Appeal Brief.

I. REBUTTAL STATEMENTS

As pages 3-6 of the Examiner's Answer constitutes a restatement of the final rejection, Appellants present the following statements in rebuttal to the arguments presented in section 11, entitled "Response to Argument," found at pages 6-17 therein.

A. APPLICANTS DEFINE THE INVENTION, NOT THE EXAMINER.

Central to the issue of patentability in the present application is the definition of certain terms defined in Appellants' specification. The terms at issue include, *inter alia*, "tasking horizon," "verbs," "churn" and "risk factor." When construed in the manner described in Appellants' specification and in sections VIII. A. in the Appeal Brief filed on August 25, 2003, the claimed invention can be readily recognized as being significantly different and patentably distinguishable over Duncan, the cited reference. The final Office Action and the Examiner's Answer, however, have distorted Appellants' stated meanings of those terms in an attempt to justify the preconceived conclusion of obviousness over the Duncan reference.

A long standing, fundamental principle in patent law recognizes that applicants have the right to be their own lexicographers, and that generally, the applicant's meanings are binding. *See, e.g., Int'l Cork Co. v. New Process Cork Co.*, 6 F.2d 420, 422 (2d Cir. 1925) (holding that "[a] patentee may define his own terms, regardless of common or technical meaning, and fairness to the patentee requires the court to accept his definition of the words, phrases, and terms."); *accord., Esnault-Pelterie v. Chance Vought Corp.*, 56 F.2d 393, 406-407, 12 U.S.P.Q. 397 (E.D.N.Y. 1932). Thus, where an applicant or patentee has set forth definitions for claim terminology in the specification, the meanings are determined by the applicant or the patentee, not the Examiner. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 U.S.P.Q. 1025, 1031 (Fed. Cir.

1984) (stating that [i]t is the inventor applying for a patent who is permitted to be his own lexicographer.") (emphasis added). *See also* MPEP §§ 2111.01, 2173.01, 2173.05(a).

In view of this long-standing principle of patent law, an Examiner is not allowed to change the meaning of an applicant's terms as he sees fit in order to force a prior art reference into meeting the redefined claims. Thus, the statement on page 7 of the Examiner's Answer (dated November 25, 2003) that "Appellants have redefined the examiner's terms" (emphasis added) is simply preposterous.

Although Examiners are permitted to interpret claim terminology more broadly than disclosed in the specification if the specification discloses more narrowing limitations which are not recited in the claims (MPEP § 2111), as "redefined" in the manner set forth in the final Office Action and Examiner's Answer, the terms "tasking horizon" and "verb" as recited in Appellant's claims are now rendered inconsistent with the specification and unworkable in the context of the invention as disclosed in the application. Moreover, by changing the meaning of Appellant's terms to conform with the definitions preferred by the Examiner, the final Office Action and Examiner's Answer violate the requirement that "[d]uring patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" MPEP § 2111 (emphasis added).

In the last paragraph on page 6 of the Examiner's Answer, the Examiner contends that "Appellant's arguments do not preclude the claim for encompassing [sic] in scope the other definitions that the examiner employs in his Final Action." This is simply not true. If the "definitions" employed by the examiner render Appellant's invention inoperative, then those "definitions" cannot be correct.

B. THE INTERPRETATION OF THE CLAIM TERMINOLOGY IN THE EXAMINER'S ANSWER IS INCONSISTENT WITH THE DISCLOSED INVENTION.

1. Tasking Horizon

As mentioned in section VIII. A. 1. in the Appeal Brief (filed August 25, 2003), a "tasking horizon" is a fixed window of time within which any of a plurality of task dates can be scheduled into or removed therefrom, so that the progress of the various tasks in a project can be measured with respect to this planning window. (*e.g.*, specification, p. 16, lns. 1-18) As such, the period of time encompassed by a tasking horizon is necessarily a window of time which is independent of any specific task in the project.

- a. The revised "definition" of "tasking horizon" presented in the Examiner's Answer is still incorrect.

The final Office Action had changed the meaning of the term "tasking horizon" to the definition preferred by the Examiner, *i.e.*, "the duration of time included in the planned time span defined by the task start and stop dates." Section VIII. A. 1. in Appellant's Appeal Brief demonstrated that the final Office Action's definition of "tasking horizon" is inconsistent with Appellant's specification. Consequently, it appears that the Examiner's Answer has changed its "definition" of the term "tasking horizon" to be "the duration of time included in the planned time span defined by all of the start and stop dates for all of the tasks of a project or activity." (Examiner's Answer dated November 25, 2003, p. 7, lns. 11-12). Essentially, it appears that the Examiner's Answer now desires the term "tasking horizon" to be defined as the time period encompassing the entire duration of the whole project.

Again, this new "definition" is a misinterpretation of the term "tasking horizon" as specifically defined by Appellant in the specification, and as restated in the Appeal

Brief. Specifically, if a "tasking horizon" is defined to encompass the time period between the start and stop dates of the entire project, then this would preclude the invention from breaking down the time frame of the project into smaller periods of time for planning purposes as discussed on page 11, lines 10-26, wherein these smaller periods of time are the tasking horizons. Thus, the interpretation of the term "tasking horizon" taken in the Examiner's Answer is incorrect.

Based on this erroneous interpretation of "tasking horizon," the Examiner's Answer maintains that Duncan meets this feature of the claimed invention. However, while Duncan discloses the concept of breaking down a project into smaller and more manageable tasks, Duncan lacks any mention whatsoever of a task-independent time frame for monitoring the performance of each task, as explained above.

b. The "tasking horizon" is task-independent.

The Examiner's Answer alleges, at the top of page 8 thereof, that "the tasking horizon cannot be independent of tasks as tasks depend on the tasking horizon for scheduling." According to the Examiner's re-definition of the term "tasking horizon," this is perhaps true. As support for this position that a time relationship exists between the "tasking horizon" and the tasks, the Examiner's Answer apparently quotes page 13, lines 18-19 in Appellant's specification: "Each day, or at set intervals, the system checks the unassigned tasks and assigns tasks that fall within the next tasking horizon."

The cited passages of Appellant's specification does not teach that a fixed relationship exists between the project tasks and the tasking horizons. Rather, this checking and assigning of unassigned tasks is performed at the end of the process discussed on pages 11 -13 and illustrated in Fig. 4. In particular, the initial planning stages of the project involves breaking down the project into tasks, and the entire estimated project time period into a number of tasking horizons.

Once the tasks are assigned, the workers input predicted start and stop dates for the tasks, and then input actual start and stop dates as they occur. It is a critical aspect of the claimed invention to have the tasking horizon functioning as a task-independent reference frame for tracking the performance of tasks. Any interpretation or definition of “tasking horizon” inconsistent with this functional role in the invention is simply wrong.

2. Verbs

In section VIII. A. 2 .in the Appeal Brief, Appellant explained that the term “verbs” used in the present invention is part of a predefined and structured set or sets of words and phrases (or reasons) that have been programmed into the modeling system of the present invention.

Lines 6-8 on page 10 of the Examiner’s Answer asserts that “Duncan discloses a Glossary of terms (see pg. 157) that may be used with the Duncan invention and that encompasses presenting verbs (and other terms) used during the various stages of an activity or project.” This Glossary which “presents verbs” is nothing more than a glossary of relevant terms used throughout the book (Duncan). The “verbs” programmed into Appellant’s invention are specific to the particular project and/or tasks, and are not necessarily applicable for all projects in general, i.e., terms of art, etc. Duncan’s Glossary, on the other hand, explains terms used in the book for generally instructing the reader on the topic of project management.

The words defined in Duncan’s glossary are not words or phrases programmed into a modeling system, prior to the start of the any work being performed on a particular project, for being selected by a worker and inputted as an explanation for each success and/or failure in meeting interim goals. Duncan simply does not disclose

any term having a meaning which resembles Appellants' "verbs." Therefore, the "verb" or "verbs" as recited in Appellants' claims are far from being anticipated or rendered obvious by Duncan.

3. Churn

In the last paragraph of page 11 in the Examiner's Answer, the Examiner appears to be applying a new ground of rejection against claim 18 at this late stage of prosecution. Nevertheless, since claim 18, as does claim 11, recites that churn is computed relative to a relevant tasking horizon, this new rejection is fatally flawed in that since Duncan is silent as to the concept of a tasking horizon as defined and used within the context of Appellant's claimed invention, the subject matter recited in claim 18 (and claim 11) cannot be anticipated or rendered obvious by Duncan.

4. Risk

As recited in claims 6 and 18 in the present application, the risk factor is computed based on differences between estimated and actual task dates relative to a tasking horizon (i.e. churn, which, in addition to the concept of a tasking horizon, is also not disclosed in Duncan), and selected verbs inputted by the project workers. In claim 8, the risk factor is calculated at least in part based on at least one risk factor for a past project.

On the other hand, the numerical risk quantification disclosed in Duncan and referenced at the bottom of page 14 in the Examiner's Answer, is a product of the probability that a given risk will occur (i.e., some type of emergency), and the monetary cost or gain that will be incurred if the given risk occurs.

Although the risk factor calculated in Appellant's claimed invention and in Duncan's risk quantification both may be numbers, the sources of input data used to determine the claimed risk factor and Duncan's risk quantification are vastly different. Thus, claims 6, 8 and 18 are not anticipated (or rendered obvious) by Duncan.

C. THE EXAMINER'S ANSWER FAILS TO SUPPORT ITS PRESUMPTION THAT NORMAL PROJECT PERFORMANCE AS SET FORTH IN DUNCAN OCCURS IN REAL TIME AS CLAIMED.

As recited in claims 1 and 10 in the application, the project performance is tracked in real time using the inputted task data. Duncan does not teach or suggest tracking or processing anything in real time. Section 3.2, as cited in the last paragraph on page 16 of the Examiner's Answer, simply discloses the sequential arrangement of process groups. As mentioned in this section in Duncan (page 28), the output of one process becomes the input to another process. The three central process groups are arranged in a loop to enable iterative sequencing. Duncan's disclosure of merely passing a result from one process to another is hardly a teaching of tracking a project in real time. The information could be passed from one project to the next on a monthly basis, weekly, daily, etc.

The Examiner's Answer further contends that section 11.4.3.2 in Duncan also discloses real time processing. This too, is found to be unsupported upon reading the relevant portion of Duncan. Section 11.4.3.2 on page 121 in Duncan teaches that estimates of risk probabilities and values and other aspects of the risk management plan should be updated "as anticipated risk events occur or fail to occur, and as actual risk event effects are evaluated." Again, this is far from a teaching of real time performance tracking of a project as claimed in the application.

Updating the estimates of risk probabilities and values is not the same as performance tracking. The former is an evaluation of risk while the latter relates to worker performance. Real time performance tracking in the claimed invention is achieved each time information is inputted by the workers themselves regarding their own performance of each task. According to the cited process in Duncan, risk information for the project is updated only when a risk event occurs or the time for a potential risk event passes without occurrence.

Beyond the two sections of Duncan cited in the Examiner's Answer, Duncan's entire disclosure is devoid of any mention or suggestion of real time processing. Absent such disclosure, the claimed invention cannot be anticipated by Duncan.

D. DUNCAN DOES NOT TEACH THE CLAIMED INVENTION

The Examiner's Answer repeatedly alleges that the specific features of Appellant's claimed invention are anticipated by Duncan because the claim elements are "encompassed" by the general concepts of project management disclosed in Duncan. For example, the bottom of page 9 in the Examiner's Answer contends that "to address changing schedule dates for activities that make require [sic] changes to the baseline schedule, [] encompasses Appellants' aspect of moving tasks into or out of the tasking horizon." In another example, the second paragraph on page 10 of the Examiner's Answer states that "Duncan discloses a Glossary of terms [] that may be used with the Duncan invention and that encompasses presenting verbs (and other terms) used during the various stages of an activity or project."

The Board need not be reminded that a claim can only be anticipated by a cited reference “if each and every element as set forth in the claim is found, either expressly or inherently described” in that reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). *See also* Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (stating that “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.”). MPEP § 2131.01.

However, when one considers the general fabric of the project management guide disclosed in Duncan next to the general fabric of the project management method and apparatus disclosed and claimed in the present application, it is clear that the two are clearly and irreconcilably distinct from one another. Specifically, Duncan is a generalized outline or guide to be used as a reference for a project manager in managing a project. The claimed invention, however, is an actual method and apparatus for implementing project management, which relies on human input and interaction with a computer software and/or network environment. The level of detail involved with the performance and operation of the claimed invention is simply not contemplated in the overview guide disclosed in Duncan.

All project management processes, plans, etc. share the same goals of cost efficiency, time efficiency, and effectiveness in the planning, scheduling, and execution of the project, from start to finish. Such broad goals, however, are not a teaching or even suggestive of the specific features of Appellants’ claimed invention.

II. CONCLUSION

For all of the reasons discussed in this Reply Brief, Appellants respectfully submit that the final rejection of obviousness over Duncan is untenable, and that the present invention as recited in claims 1, 6-8, 10-12 and 18 are allowable. Accordingly, reversal of the rejection under 35 U.S.C. 102 is courteously solicited.

Dated: January 26, 2004

Respectfully submitted,

By 

Jon D. Grossman

Registration No.: 32,699

Ellen S. Tao

Registration No.: 43,383

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant